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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/032,948

12/26/2001

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09/06/2006

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EXAMINER

FLANDERS, ANDREW C

ART UNIT

PAPER NUMBER

2615

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/032,948		SUYAMA ET AL.	
	Examiner		Art Unit	
	Andrew C. Flanders		2615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10,20-26 and 30-33 is/are pending in the application.
- 4a) Of the above claim(s) 7-10,25,26,32 and 33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,6,20-24,30 and 31 is/are rejected.
- 7) ☒ Claim(s) 3-5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 07 July 2006 have been fully considered but they are not persuasive.

Applicant alleges:

“Applicants respectfully submit that the Examiner's restriction requirement via combination/subcombination distinctness is improper in this instance. Specifically, as the Examiner noted, a restriction under combination/subcombination is proper only when it can be shown that a combination as claimed (A) does not require the particulars of the subcombination as claimed for patentability, and (B) the subcombination can be shown to have utility either by itself or in another materially different combination (M.P.E.P. 806.05(c)).”

Examiner respectfully disagrees. In the set of originally filed claims, claim 1 was an independent claim directed to a digital mixing system containing a console and engine section (i.e. Ab_{br}), claim 7 was an independent claim directed to an engine apparatus (i.e. B_{sp}) and claim 9 was an independent claim directed toward a console apparatus (i.e. B_{sp}). The MPEP states in (M.P.E.P. 806.05(c)): “Since claims to both the subcombination and combination are presented, the omission of details of the claimed subcombination B_{sp} in the combination claim Ab_{br} is evidence that the combination does not rely upon specific limitations of the subcombination for its patentability.” “If subcombination B_{sp} has separate utility, the inventions are distinct and restriction is proper...” As shown previously, the mixer does not rely upon the specifics of the console and engine and they have separate utility. In the most recent claim

presentation, claims 7 and 9 were re-written to exclude the engine and console portion and to depend upon claim 1. However, merely excluding the name does not change what the claim is directed toward. It is clear from a brief review of the drawings that claim 7 still corresponds to the engine apparatus in Fig. 4 and Claim 9 still corresponds to the console apparatus in Fig. 3. Simply removing the name has not distinguished the claims from these two drawings.

Applicant further alleges:

"In this instance, the claims identified in Groups II and III above cannot be considered a subcombination having utility either by itself or in another materially different combination. Rather, per the Amendments dated November 7, 2005 and January 17, 2006, the claims of Groups II and III are dependent from independent claims identified in Group 1, and are all accordingly directed to a digital mixer. Claims 7, 8, 25, and 32 are not directed to an engine, as the Examiner identified; nor, are Claims 9, 10, 26, and 33 drawn to a console, as the Examiner identified. Rather, Claims 7-10 and 25-33 are simply dependent claims that further limit the scope of the independent claims. More importantly, Claims 7-10 and 25-33 are directed to the same combination identified in their respective independent claims. Indeed, as stated in the M.P.E.P., any claim to a combination AB_{sp} should be grouped with combination AB_{br} (M.P.E.P. 806.05(c)(II)(B))."

Examiner respectfully disagrees. First, the groupings II and III are directed toward an engine and console section. A brief correlation of the claim limitations to figures 3 and 4 confirms this fact. Applicant states that the claims in groups II and III are directed to a digital mixer due to their dependence upon the claims of the generic mixer. This is not the case, the generic independent claims merely link the inventions as shown in the previous restriction. The other groups, II and III still have separate

Art Unit: 2615

utility and are not directed toward a mixer as alleged by Applicant. Applicant is also stating that AB_{sp} should be grouped with AB_{br}. While this is true, AB_{sp} and AB_{br} do not appear in this application, merely AB_{br} and B_{sp}. Simply because Applicant has rewritten the console and engine claims to depend upon the mixer claim, and removed their naming convention, does not make the claims AB_{sp}. The are still directed toward the engine and console and thus are B_{sp}.

In view of the above, the restriction is made final. Group I including claims 1 – 6, 20 – 24 and 30 – 31 will be examined on the merits.

Applicant is reminded again that the restriction requirement between the linked inventions is subject to the nonallowance of the linking claims, claims 1 and 22. Upon the indication of allowability of the linking claims, the restriction requirement as to the linked inventions shall be withdrawn and any claims depending from or otherwise requiring all the limitations of the allowable linking claims will be rejoined and fully examined for patentability in accordance with 37 CFR 1.104. Claims that require all the limitations of an allowable linking claim will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116., amendments submitted after allowance are governed by 37 CFR 1.312.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 6, 20 – 24, 30 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by East (U.S. Patent 6,061,458).

Regarding **Claim 1**, East discloses:

A digital mixing system (Fig. 1) having a plurality of input signal systems and a plurality of output signal systems (Fig. 1 element 18), wherein input signals from said plurality of input signal systems are subjected to a mixing process and the mixed signals are output to said plurality of output signal systems (col. 1 lines 50 – 55), the system comprising:

a console section (Fig. 1 element 12) including panel operating elements used to input parameters relating to the mixing process (i.e. the panel 12 comprises an array of operator controls including faders, switches, rotary controllers, video display units, etc... col. 4 lines 35 – 65), a first input terminal (i.e. various input output devices; col. 5 lines 1 – 10), a first communication interface (i.e. console 10 is connected to other devices for the communication of audio and control data between the processor; col. 5 lines 1 – 10), and a first control device that generates a mixing control signal in response to

Art Unit: 2615

operation of said panel operating elements or to a first control signal input via said first input terminal or said first communication interface, and outputs the mixing control signal to said first communication interface (i.e. console 10 is connected to other devices for the communication of audio and control data between the processor; col. 5 lines 1 – 10);

an engine section (Fig. 1 element 14) including a second input terminal (connection of network 14 to the I/O interface 18), , a second communication interface (the connection of console 10 to processor network 14), a mixing processing device that executes the mixing process of mixing the input signals from said plurality of input signal systems and outputting the mixed signals to said plurality of output signal systems (Audio signal processing side element 15 in figs 1 and 3), and a second control device that controls the mixing process executed by said mixing processing device in response to the mixing control signal input via said second communication interface and outputs a second control signal input via said second input terminal to said second communication interface (i.e. control side 16 of network 14; Figs 1 and 3); and

communication lines connecting between said first communication interface and said second communication interface (Fig. 1 the connection between elements 14 and 10).

Regarding **Claim 2**, East discloses:

A digital mixing system (Fig. 1) having a plurality of input signal systems and a plurality of output signal systems (Fig. 1 element 18), wherein input signals from said

plurality of input signal systems are subjected to a mixing process and the mixed signals are output to said plurality of output signal systems (col. 1 lines 50 – 55), the system comprising:

a console section (Fig. 1 element 10) including panel operating elements used to input parameters relating to the mixing process (i.e. the panel 12 comprises an array of operator controls including faders, switches, rotary controllers, video display units, etc... col. 4 lines 35 – 65), a panel display device that displays contents of the mixing process (i.e. video display units; col. 4 lines 35 – 65), a first computer connection terminal (i.e. various input output devices; col. 5 lines 1 – 10), a first communication interface (i.e. console 10 is connected to other devices for the communication of audio and control data between the processor; col. 5 lines 1 – 10), and a first control device that updates the contents displayed by said panel display device (one or more of the video display units on the panel can then be used as the display for the general purpose computer; col. 4 lines 45 – 5) and generates a mixing control signal, in response to operation of said panel operating elements or to a first control signal input via said first computer connection terminal or said first communication interface, and outputs the generated mixing control signal to said first communication interface (i.e. console 10 is connected to other devices for the communication of audio and control data between the processor; col. 5 lines 1 – 10);

an engine section (Fig. 1 element 14) including a second computer connection terminal (connection of network 14 to the I/O interface 18), a second communication interface (the connection of console 10 to processor network 14), a mixing processing

Art Unit: 2615

device that executes the mixing process of mixing the input signals from said plurality of input signal systems and outputting the mixed signals to said plurality of output signal systems (Audio signal processing side element 15 in figs 1 and 3), and a second control device that controls the mixing process executed by said mixing processing device in response to the mixing control signal input via said second communication interface and outputs a second control signal input via said second computer connection terminal to said second communication interface (i.e. control side 16 of network 14; Figs 1 and 3); and

communication lines connecting between said first communication interface and said second communication interface. (Fig. 1 the connection between elements 14 and 10).

Regarding **Claim 6**, East discloses:

A digital mixing system (Fig. 1) having a plurality of input signal systems and a plurality of output signal systems (Fig. 1 element 18), wherein input signals from said plurality of input signal systems are subjected to a mixing process and the mixed signals are output to said plurality of output signal systems (col. 1 lines 50 – 55), the system comprising:

an engine section (Fig. 1 element 14) including a mixing processing device (Fig. 1 element 16) that executes the mixing process of mixing the input signals from said plurality of input signal systems and outputting the mixed signals to said plurality of

Art Unit: 2615

output signal systems (col. 5 lines 45 – 55), and a computer connection interface (the connection of console 10 to processor network 14); and

a supply device (Fig. 1 element 10) that is connected to said computer connection interface (the connection of console 10 to processor network 14) and supplies a mixing control signal for controlling the mixing process executed by said mixing processing device to said engine section (col. 5 lines 45 – 55).

Regarding **Claim 20**, in addition to the elements stated above in claims 1, 2 and 6 East further discloses:

an engine section including a monitor process selectively outputting the signals being mixed by the mixing process, as monitor signals (col. 6 lines 60 – 67), and a second control device that controls the mixing process and the monitor process based on the mixing control signal output from said first control device (i.e. access control buttons; col. 6 lines 35 – 67);

wherein at least part of the mixing signals are reproduced by at least one stage speaker arranged close to said engine section, and the monitor signals are reproduced by at least one monitor speaker arranged closed to said console section (i.e. particular instrument may be monitored, typically using the studio monitor loudspeakers; col. 6 lines 35 – 65), and

wherein said panel operating elements of said consol section include at least one operating element used to control a delay time for the monitor signals (col. 3 lines 35 – 40).

Regarding **Claim 21**, in addition to the elements stated above in claims 1, 2 and 6 East further discloses:

wherein said engine section further comprises a communication signal system to which a voice signal close to said engine section is input (i.e. a microphone input).

wherein the monitor process executed by said processing device of said engine section comprises reducing a level of said first monitor signal if a level of the voice signal input to the communication signal system exceeds a predetermined value, mixing the first monitor signal and the voice signal input to said communication signal system, and outputting the mixed signal as a second monitor signal (col. 3 lines 55 – 67 and col. 4 lines 1 – 5)

Regarding **Claims 22 – 24**, claims 22 – 24 recite the method of the operation of the system claims of claims 1, 2 and 6 and thus are rejected under the same grounds.

Regarding **Claims 30 and 31**, claims 30 and 31 recite the method of the operation of the system claims of claims 20 and 21 and thus are rejected under the same grounds.

Allowable Subject Matter

Art Unit: 2615

Claims 3 – 5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kumai (U.S. Patent 7,006,642).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew C. Flanders whose telephone number is (571) 272-7516. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on (571) 272-7546. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

acf


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